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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/805,548

03/18/2004

Wolf-Dietrich Freund

Le A 33 469 D1

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08/21/2006

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EXAMINER

ANDERSON, REBECCA L

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/805,548	FREUND ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Rebecca L. Anderson	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) 4-10 and 15-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 11 is/are rejected.
- 7) ☒ Claim(s) 1-3 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09980243.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 1-11 and 15-21 are currently pending in the instant application. Claims 4-10 and 15-21 are withdrawn from consideration as being for non-elected subject matter. Claims 1-3 and 11 are objected to as containing non-elected subject matter and rejected as being indefinite.

### ***Election/Restrictions***

Applicant's election of Group I and the further election of the specific compound of example 14 in the reply filed on 12 June 2006 is acknowledged. It is noted on page 1 of the reply applicant states that applicant plans to review the remaining claims once the scope of claim 1 is determined and make any amendments necessary to make them commensurate in scope with claim 1 so that rejoinder of as much of the presently-claimed subject matter will be facilitated.

Therefore, as stated on pages 4 and 5 of the restriction requirement, applicants election of Group I and the further election of the compound of example 14 has resulted in the following elected invention for search and examination.

### **The elected invention for search and examination is:**

The compounds of the formula (I) wherein **A**, **D**, **E** and **G** each represent CH groups;

**L1** and **L2** are as found in claim 1;

**R1** represents a radical of the formula CO-NR<sub>4</sub>R<sub>5</sub> in which **R4** and **R5** are as found in claim 1;

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**R2** represents (C1-C8)alkyl which is not interrupted and where the (C1-C8)-alkyl is substituted by one to three hydroxyl groups; and

**R3** represents a phenyl or naphthyl ring where the rings are optionally mono- or polysubstituted by radicals as found in claim 1, and a salt thereof.

The remaining subject matter of claims 1-3 and 11 that is not drawn to the above elected invention and the subject matter of claims 4-10 and 15-21 stands withdrawn under 37 CFR 1.142(b) as being for non-elected subject matter. The remaining compounds which are not within the elected invention, which are independent and distinct from the elected invention and do not have unity with the elected compound and are therefore withdrawn by means of a restriction requirement within the claims are, for example, the compounds of the formula (I) wherein any number of A, D, E and G are nitrogen; R1 is the group CH<sub>2</sub>-OH; R2 represents (C3-C8)-cycloalkyl, 4-to 8-membered saturated heterocycle, C1-C8 alkyl interrupted by an oxygen or sulphur atom or by a radical NR<sub>6</sub>; C1-C8-alkyl substituted by a radical of the formula -NR<sub>8</sub>R<sub>9</sub>; and/or R3 is pyrimidinyl, pyridyl, furyl or thienyl, etc.

The above mentioned withdrawn compounds which are withdrawn from consideration as being for nonelected subject matter differ materially in structure and composition from the compounds of the elected invention. The withdrawn compounds differ from those of the elected invention, such as by furanyl, thienyl, pyrimidinyl, pyridyl, etc. which are chemically recognized to differ in structure and function. This recognized chemical diversity of the compounds can be seen by the various classification of these

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compounds in the U.S. classification system, i.e. class 549 subclass (200)+ furanyl, class 549 subclass (1)+ thienyl, etc. Therefore, again, the compounds which are withdrawn from consideration as being for non-elected subject matter differ materially in structure and composition and have been restricted properly as a reference which anticipated but the elected subject matter would not even render obvious the non-elected subject matter.

These withdrawn compounds are independent and distinct from the elected invention and do not have unity with the species elected and are therefor withdrawn by means of a restriction requirement within the claims.

The requirement is still deemed proper.

### ***Claim Objections***

Claims 1-3 and 11 are objected to as containing non-elected subject matter. Claims 1-3 and 11 presented drawn solely to the elected invention identified supra as **the elected invention for search and examination** would overcome this objection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the term "general" renders the claims indefinite. The use of the term "general" in the phrase "Compounds of the general formula (I)" in claim 1 and the phrase "a compound of the general formula (I)" in

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claim 11 renders the claims indefinite since the term general is defined as, for example, as involving only the main features and not limited in scope (Webster's II New Riverside University Dictionary, 1984). Therefore, it is unclear what compounds are encompassed by the instant claims since the claims are directed to the general formula (I), which is not limited to the compound described as formula (I) but also includes other compounds outside the scope of the compounds of the formula (I). It is suggested that the term "general" be deleted from the claims to overcome this rejection.

### ***Closest Art***

The closest prior art of record is US Patent No. 5,935,983 which differs from applicants' instant elected invention in the position equivalent to applicants instant R2. The prior art does not anticipate or render obvious applicants' instant elected invention wherein R2 represents (C1-C8)alkyl substituted by one to three hydroxyl groups.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday 5:30AM to 2:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Rebecca Anderson", is written over a horizontal line.

Rebecca Anderson  
Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600

August 17, 2006